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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/539,129

04/10/2006

Deepak Murpani

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26815 7590 06/07/2007

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EXAMINER

MERCIER, MELISSA S

ART UNIT

PAPER NUMBER

1615

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/539,129	Applicant(s) MURPANI ET AL.	
	Examiner Melissa S. Mercier	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 April 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,6,7,9-13,16-27 and 45-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,6,7,9-13,16-27 and 45-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Summary**

Receipt of Applicants Remarks and Amended Claims filed on April 4, 2007 is acknowledged. Applicant has cancelled Claims 2-5, 8, 14-15, and 28-44. New claims 50-51 have been added. Claims 1, 6-7, 9-13, 16-27, and 45-51 are pending in this application.

Applicants' arguments, filed April 4, 2007, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous Office Actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 6-7, 9, 11-13, 17-26, 45, and 48-51 are rejected under 35

U.S.C. 102(b) as being anticipated by Addicks et al. (US PG-Pub 2001/0043945).

Addicks discloses, "a pharmaceutical composition containing an admixture of phenytoin sodium and an erodible matrix which extends the release of the phenytoin sodium over about a two hour period. The erodible matrix comprises binder(s) and diluent(s) which control the release of drug from the pharmaceutical composition" (abstract). Binders are defined as compounds, which cause agglomeration of drug, and excipient particles during the manufacturing process and act to control the release of the drug from the dosage form. The agglomeration can be in the form of a powder. The dosage unit can be in the form of a capsule.

Regarding Claim 6, Addicks discloses "the amount of phenytoin sodium provided ranges from about 5% to about 90% per dosage unit" (paragraph 0017).

Regarding Claim 7, Addicks discloses, "the erodible matrix comprises about 1% to about 35% binder" (paragraph 0019).

Regarding Claims 9, 11-13 and 17-25, Addicks discloses, binders include "acacia, ethylcellulose, guar gum, hydroxypropyl cellulose, hydroxypropylmethyl cellulose, hydroxyethylcellulose, starch, and hydrogenated vegetable oil" (paragraph 0013). The binders can be used in combination or alone. Additionally, diluents include "microcrystalline cellulose, powdered cellulose, lactose, starch, mannitol, dextrose, and dibasic calcium phosphate" (paragraph 0014). Lubricants including talc and magnesium stearate and glidants including talc and colloidal silicon dioxide, are disclosed (paragraph 0016).

Regarding Claims 45 and 48, phenytoin sodium is well known in the art for the treatment of epilepsy (paragraph 0003), therefore administration of the instantly claimed

composition would inherently treat the symptoms of epilepsy, including generalized tonic-clonic and complex partial seizures.

Regarding Claims 2-3, 26, and 49-51, since the prior art teaches the same composition claimed in the instant claims, it would inherently meet the limitations of function as claimed in the above referenced claims. Applicant is reminded that where the general conditions of the claims are met, burden is shifted to applicant to provide a patentable distinction. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. See *In re Aller*, 220 F.2d 454 105 USPQ 233,235 (CCPA 1955).

### ***Response to Arguments***

Applicant's arguments have been fully considered but they are not persuasive. Applicant argues Addicks does not describe or suggest a capsule that has a powder blend of phenytoin sodium and one or more hydrophilic polymers. Instead, the capsule contains compressed tablets that contain a blend that includes an erodible matrix of phenytoin sodium, polymers and other excipients. Applicants submit that a compressed tablet cannot be characterized as a powder blend. The Examiner disagrees. It is the examiners position that Addicks discloses an admixture of phenytoin sodium and an erodible matrix and the agglomeration can be in the form of a powder. It is noted that applicant is not claiming a loose powder in the capsule; therefore a compressed powder composition would meet the limitations of the instant claims.

Claims 1, 6-7, 9, 11-13, 17-19, 26-27 and 49-51 are rejected under 35 U.S.C. 102(e) as being anticipated by Straub et al. (US Patent 6,395,300).

Straub discloses a drug formulation comprising a low aqueous solubility drug provided in a porous matrix (abstract). Phenytoin sodium is disclosed as a suitable drug (column 5, line 44) and the drug matrix is in the form of powder (column 13, lines 29-31). Additionally, the matrices also may contain hydrophilic excipients such as water soluble polymers or sugars, wetting agents including acacia gum, surfactants, and tonicity agents" (Column 3, lines 50-53). Straub further teaches, "the porous drug matrix can be processed into capsules for oral administration" (column 3, lines 4-6).

Straub discloses the hydrophilic polymers can include "hydroxyethyl cellulose, hydroxypropyl cellulose, hydroxyl-propylmethyl cellulose, and carboxymethyl cellulose" (column 8, lines 45-49).

Regarding Claims 2-3, 26 and 49, the prior art discloses the same composition as the instant claims. Applicant is reminded that where the general conditions of the claims are met, burden is shifted to applicant to provide a patentable distinction. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. See *In re Aller*, 220 F.2d 454, 105 USPQ 233,235 (CCPA 1955). The recitation of "the matrix retains at least about 20%, 30%, or 60% at one hour" and the dissolution profile of the composition are considered function limitations. The USPTO does not have laboratory facilities in order to ascertain the functional limitations claimed.

Regarding Claim 6, "the porous drug matrix is at least 1-95% drug by weight" (column 3, lines 48-50).

Regarding Claim 7, Straub discloses, the amount of excipients in the drug matrix is less than 95% (column 8, lines 29-31). Straub defines excipients to include the hydrophilic polymers.

Regarding Claims 17-19, Straub discloses sugars such as "mannitol, dextrose and lactose" can be added to the drug matrix formulation (column 8, lines 58-65).

Regarding Claim 27, the selected drug is dissolved in an appropriate solvent; the drug solution is combined, typically under mixing conditions, with the pore forming agent or solution thereof. A solid pore forming agent can be added directly to the drug solution as solid particulates, preferably between about 100 nm and 10 um in size, to form a suspension of pore forming agent in the drug solution. Subsequently, further processing the resulting suspension, for example, using homogenization or sonication techniques known in the art, can reduce the solid pore forming agent particle size. Then, the solution, emulsion, or suspension is further processed to remove the drug solvent and the pore forming agent simultaneously or sequentially, using evaporation, spray drying, fluid bed drying, lyophilization, vacuum drying, or a combination of these techniques. The solvent and pore forming agents evaporate from the droplets into the drying gas to solidify the droplets, simultaneously forming pores throughout the solid. The solid (typically in a powder, particulate form) then is separated from the drying gas and collected" (column 11, line 47 to column 12, line 41). Since Straub discloses the

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dosage form can be in the form of capsules, it is the examiners position that capsules would be filled with the above resulting powder.

### ***Response to Arguments***

Applicant's arguments have been fully considered but they are not persuasive. Applicant argues impermissible hindsight. The examiner disagrees. The prior art reference discloses all the limitations of the instant claims and it is therefore, the examiners position that Straub anticipates the instant claims. Additionally, since Straub discloses the dosage form can be in the form of capsules, it is the examiners position that one of ordinary skill in the art would have the knowledge to make capsules would be filled with the above resulting powder.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.



4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 10 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Straub et al. (US Patent 6,395,300) or in the alternative Addicks et al. (US PG-Pub 2001/0043945) in view of Pankhania et al. (US Patent 5,415,871).

The teachings of Straub and Addicks are discussed above and applied in the same manner.

Neither Straub nor Addicks disclose the use of xanthan gum or a combination of hydroxypropyl cellulose, hydroxypropyl methylcellulose and xanthan gum.

Pankhania discloses, "a sustained release pharmaceutical formulation comprising xanthan gum" (abstract).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined the teachings of Straub's and Addicks' teachings with the teachings of Pankhania since Pankhania discloses, "the use of xanthan gum in the sustained release carrier generally allows a slower release of active ingredient into

the body as compared to the use of naturally occurring hydrophilic gums. As a result, this provides the advantage that the proportion of sustained release carrier in the formulation may be reduced compared to most other sustained release formulations, thus enabling the sustained release formulation to be provided in a relatively small solid dosage form, if desired. As the proportion of sustained release carrier in the formulation is increased, the release of the active ingredient from the formulation is slowed" (column 3, lines 53-64).

One of ordinary skill in the art at the time the invention was made would have a reasonable expectation of success in making the extended release tablet, since the cited references all teach similar tablets.

### ***Response to Arguments***

Applicant's arguments have been fully considered but they are not persuasive. Applicant has not provided additional arguments over those discussed above pertaining to the above rejection.

Claims 46-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Addicks et al. (US PG-Pub 2001/0043945) in view of Jao et al. (US Patent 5,660,861).

The teachings of Addicks are discussed above and applied in the same manner.

Addicks does not disclose the use of additional pharmaceutical active agents.

Jao discloses "a dosage form for delivering an antiepileptic drug in a continuous release dose over time" (column 2, lines 61-64). Phenytoin sodium is disclosed as a suitable drug (column 6, line 58).

Regarding Claim 45, phenytoin sodium is well known in the art for the treatment of epilepsy (column 6, lines 53-54), therefore administration of the instantly claimed composition would inherently treat the symptoms of epilepsy, including generalized tonic-clonic and complex partial seizures.

Regarding Claims 46-47, Jao discloses the use of "adjunctive antiepileptic drugs comprising phenytoin and phenobarbitone" (column 7, lines 14-16).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined the teaching of Addicks with the drug combination of Jao.

It is generally considered to be prime facie obvious to combine compounds each of which is taught by the prior art to be useful for the same purpose in order to form a composition that is to be used for an identical purpose. The motivation for combining them flows from their having been used individually in the prior art, and from them being recognized in the prior art as useful for the same purpose. As shown by the recited teachings, instant claims are no more than the combination of conventional components of drugs used for the treatment of epilepsy. It therefore follows that the instant claims define prime facie obvious subject matter. Cf. In re Kerhoven, 626 F.2d 848, 205 USPQ 1069 (CCPA 1980).

### ***Response to Arguments***

Applicant's arguments have been fully considered but they are not persuasive. Applicant has not provided additional arguments over those discussed above, regarding Addicks and Straub, pertaining to the above rejection.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

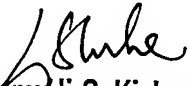
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa S. Mercier whose telephone number is (571) 272-9039. The examiner can normally be reached on 7:30am-4pm Mon through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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